

REMARKS

Claims 1-29 are pending in the application.

Claims 1-29 have been rejected.

Claims 1 and 15-21 have been amended, as set forth herein.

I. STATUS OF APPLICATION

On November 13, 2006, Applicant filed its full Appeal Brief. In response, the Office reopened prosecution and issued the current outstanding Office Action. The new Office Action raises a new rejection of Claim 15-21 under § 112, and raises a new rejection of Claims 1-7 and 29 under § 101. Applicant respectfully submits that these two new rejections could have been raised during the prior prosecution -- not raised for the first time upon reopening of prosecution after Applicant filed its Appeal Brief. In addition, the Office Action has withdrawn the prior § 102 rejection of Claims 1-7 and 29 but is now rejecting these claims based on text from the Office's Manual of Patent Examining Procedure (MPEP).

II. REJECTION UNDER 35 U.S.C. § 112

Claims 15-21 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The rejection is respectfully traversed.

To further prosecution, Applicant has amended these claims to recite that the embedded

processing system comprises a memory configuration designed according to the method as set forth [in a previous claim]. Therefore, Applicant respectfully submits these claims are definite.

Accordingly, the Applicant respectfully requests withdrawal of the § 112 rejection of Claims 15-21.

III. REJECTION UNDER 35 U.S.C. § 101

Claims 1-7 and 29 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The rejection is respectfully traversed.

However, to further prosecution of this application, Applicant has amended Claim 1 to recite the apparatus comprises a processing system which comprises the other recited elements..

Accordingly, the Applicant respectfully requests withdrawal of the § 101 rejection of Claims 1-7 and 29.

IV. REJECTION UNDER 35 U.S.C. § 102

Claims 8-28 were rejected under 35 U.S.C. § 102(b) as being anticipated by Giorgi (“An Educational Environment for Program Behavior Analysis and Cache Memory Design”, 1997 Frontiers in Education Conference, Proceedings of Teaching and Learning in an Era of Change, 1997, Volume 3, pages 1243-1248). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they

are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicant reiterates, and incorporates by reference herein, its responses, arguments and reasoning as set forth in Applicant's Appeal Brief filed November 13, 2006 (and prior responses) with respect to the 102 rejection of Claims 8-28.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claims 8-28.

V. REJECTION UNDER 35 U.S.C. § 103

Claims 1-7 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Giorgi ("An Educational Environment for Program Behavior Analysis and Cache Memory Design", 1997 Frontiers in Education Conference, Proceedings of Teaching and Learning in an Era of Change, 1997, Volume 3, pages 1243-1248) in view of MPEP 2144.04(III). The rejection is respectfully traversed.

Applicant reiterates, and incorporates by reference herein, its responses, arguments and reasoning as set forth in Applicant's Appeal Brief filed November 13, 2006 (and prior responses) with respect to Claims 1-7 and 29.

The Office appears to argue that each and every element/feature of Claim 1 is disclosed in

Giorgi except for the simulation controller, memory access controller, and memory optimization controller. However, the Office Action further argues, these are implementable as software programs to replace “manual activities” that accomplish the same result (see, Office Action, page 9), and therefore, it would be obvious to modify Giorgi to incorporate the legal precedent teachings of automating a manual activity to obtain the invention (a routine expedient).

As noted above (and set forth in Applicant’s Appeal Brief and prior responses), Giorgi does not disclose each and every element/feature – either structurally or functionally (or results) – as recited in independent Claim 1. Therefore, the Office’s citation to the MPEP (and In re Venner) is irrelevant - as the Office has failed to establish that Giorgi teaches all of the functional elements/features recited in Claim 1. Moreover, the elements/features recited in Claim 1 do not appear to be “broadly” providing an automatic means to replace a manual activity which accomplishes the same result. Applicant submits that its apparatus accomplishes a different result than Giorgi. Thus, In re Venner is inapplicable.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 1-7 and 29.

VI. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

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